

REMARKS

The Office Action dated August 23, 2005 has been carefully considered. Responsive thereto, Applicant has amended the claims as indicated above, and requests that the Examiner consider the following remarks.

The drawings were objected to due to informalities regarding reference sign "40", and cross hatching inconsistencies. Claim 1 was objected to due to awkward phrasing in the last line thereof. Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Herr (4,526,281) in view of Yeager (5,207,341).

Claim 1 has been amended. Claims 2 - 4 have been added. Claims 1 - 4 remain pending. No new matter has been added. Reconsideration is respectfully requested.

The claims have been amended to a scope that is considered to be allowable in view of the issues raised by the Examiner in the Office Action.

Applicant responds to the informalities regarding the drawings, by filing three replacement drawing sheets (FIGS. 1 - 6) herewith.

Rejections Under 35 U.S.C. §103(a)

The claims were rejected under 35 U.S.C. §103(a) as being unpatentable over 35 U.S.C. 103(a) as being unpatentable over Herr (4,526,281) in view of Yeager (5,207,341), and alternately as being unpatentable over Brennan (5,924,588) in view of Yeager. Applicant respectfully requests reconsideration of the rejections as the cited references do

not appear to teach or suggest, alone or in combination, the claimed structure and function of Applicant's invention.

U.S. Patent No. 4,526,281, issued to Herr, discloses a vial and closure cap that may be used in a child-resistant mode or in a non-child resistant mode. Herr discloses a sealing plug (21) that is tapered and engages the vial using a detenting means (51) inside the vial to "hold the sealing plug 21 against sliding outwardly." See, Col. 2, lines 45 – 52. The Examiner acknowledges that Herr fails to disclose the circumferential outer skirt as disclosed and claimed by Applicant in the present invention.

U.S. Patent No. 5,924,588, issued to Brennan also discloses a vial system having a reversible cap to engage the vial in a child-resistant manner on one side, and a non child-resistant manner on the other side. The Examiner acknowledges that Brennan also fails to disclose the circumferential outer skirt as disclosed and claimed by Applicant in the present invention.

In an attempt to overcome the deficiencies present with the Herr and Brennan references, the Examiner relies on the Yeager reference to provide the circumferential outer skirt disposed in spaced surrounding relation with the plug outer surface. The Yeager reference is directed to a beverage container and cap, and primarily provides a drinking container (such as a cola container) having a smooth exterior drinking surface.

Yeager does not at all relate to reversible child resistant closure systems. Accordingly, the Yeager reference is non-analogous art, and as such does not properly support rejection of the claims under 35 U.S.C. 103(a). The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the

benefit of hindsight, is insufficient to present a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992).

IMPROPER COMBINATION OF REFERENCES

Even if the Yeager reference was considered an analogous reference, it fails to either teach or suggest the circumferential outer skirt disclosed by Applicant. More particularly, assuming that Yeager depicts a skirt (22) as stated by the Examiner, Yeager fails to either teach or suggest upper and lower circumferential skirts disposed in concentric relation as disclosed by Applicant. Applicant's reversible cap having concentrically disposed upper and lower skirts with the upper skirt disposed radially inward relative to the lower skirt provide the user with tactile feedback that assists in determining proper orientation of the cap for either child resistant or non child resistant closure.

Finally, even if Yeager disclosed a skirt configuration, Applicant is unable to find any teachings or suggestions that it would be desirable to combine the references to form a reversible closure as suggested by the Examiner. It is axiomatic that in order to justify combination of references it is not only necessary that it be physically possible to combine them, but that the art contain something to suggest the desirability of doing so. Ex parte Walker, 135 U.S.P.Q. 195 (1961). Furthermore, the Examiner must identify where the prior art provides a motivating suggestion for the combination. In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). The Federal Circuit, in In re Jones, confirmed that "[b]efore the PTO may combine the disclosures of two or more prior art references in order

to establish prima facie obviousness, there must be some suggestion for doing so . . .” (citing In re Fine, 837 F.2d 1071, 1074 (Fed Cir. 1988)).

As discussed above, the various references cited by the Examiner fail to teach or suggest the presently claimed invention, either alone or in combination. In addition, the cited references fail to teach or suggest the desirability of the combined teachings relied on by the Examiner. Accordingly, the proposed combinations are improper and fail to support rejection under 35 U.S.C. § 103. See, C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 48 USPQ.2d 1225 (Fed. Cir. 1998) (There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination).

It is improper to use the inventor’s disclosure as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987). During prosecution, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987) (A holding that claims are invalid based merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting Title 35). As the Federal Circuit has often stated, “virtually all [inventions] are combinations of old elements.” Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983).

Accordingly, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the law requires the examiner to show a motivation to combine the references that create the case of obviousness. In Re Rouffet, 149 F.3d 1350,

1357 (Fed. Cir. 1998). The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, is not evidence.

The Federal Circuit has identified three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. Id. In the present case the Examiner relies upon none of the three possible sources for motivation. Instead, after each citation of a particular feature in the cited art, the Examiner summarily concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of X by combining Y.” The Examiner has not, however, explained what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination. When the Examiner does not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the present invention to make the combination, it is presumed that the Examiner selected the references with the assistance of hindsight. Id. at page 1358.

While a suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art, Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ.2d 1481 (Fed. Cir. 1997), rarely will the skill in the art operate to supply missing knowledge or prior art to reach an obviousness judgment. In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). If such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Id.

In Ex Parte Clapp, 227 USPQ 972, claims were rejected under 35 U.S.C. §103 when the Examiner combined a number of references. The Board in Clapp set out the requirement that the Examiner state a line of reasoning as to why the artisan, viewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. The Board in Clapp noted that the Examiner had done little more than “cite references to show that one or more elements or sub-combinations thereof, when each is viewed in a vacuum, is known. 227 USPQ at 973. The Board held that “to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” 227 USPQ 972, 973. The Board could not find anything in the references to expressly or impliedly teach or suggest the modifications urged by the Examiner, nor could the Board find a line of reasoning advanced by the Examiner as to why the artisan would have concluded that the modifications urged by the Examiner were obvious. The Board held that, on the record before it, “the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide.”

Applicants also rely on the decision of the Court of Appeals for the Federal Circuit in Carella v. Starlight Archery, 231 USPQ 644. One of the issues in Carella was the obviousness of the invention over the prior art. The CAFC noted that the Court below had acknowledged that use of vertical height for range finding, use of multiple elements on a

sight and use of circular apertures were each known in the art, but concluded that the prior art lacked any teaching or suggestion to combine the separate features in a manner permitting use of circular apertures for simultaneous range finding. Obvious cannot be established by combining the teachings of the prior art to produced the claimed invention absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

Both Carelly and Clapp stand for the proposition that the art, not the Examiner, must teach the suggested combination. Further, if the references do not expressly or impliedly suggest the claimed combination then the burden falls on the Examiner to advance a line of reasoning which supports the position advanced by the Examiner.

In Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1498, 1 USPQ.2d 1337, 1343 (Fed. Cir. 1986), the court stated: “the question is not simply whether the prior art ‘teaches’ the particular element of the invention, but whether it would suggest the desirability, and thus the obviousness, of making the combination.” The record does not reveal any such suggestion or teaching that would lead to the Applicants’ claimed invention.

In view of the amendments and arguments presented herein it is believed that that the claims are patentably distinguishable over the prior art. Accordingly, Applicants respectfully requests a favorable action on this case.


Should the Examiner have any questions, comments, or concerns, the undersigned would appreciate a telephone conference in order to expedite this case.

Respectfully submitted,

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